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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,284	01/11/2002	Timothy E. Bishop	P 283277 D1126	4561

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EXAMINER

MCCLENDON, SANZA L

ART UNIT PAPER NUMBER

1711

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,284

Applicant(s)

BISHOP ET AL.

Examiner

Sanza L McClendon

Art Unit

1711

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,10-15 and 17-23 is/are rejected.
- 7) ☒ Claim(s) 2,3,9 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on October 20, 2003, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 4 and 10.

Response to Arguments

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 5-8, 10-15, and 17-23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishikawa et al (99/52958) as evidenced by Chawla et al (5,977,202).

Ishikawa et al teaches radiation curable composition for primary coatings of optical fibers. This anticipates claim 19. Said composition comprises a polymer containing polymerizable unsaturated groups and urethane bond, a polyfunctional monomer having two or more polymerizable groups, a monomer having one polymerizable group, and radiation activate initiator, wherein said viscosity is in the range from 1,000 to 20,000 cps, preferably from 1,500 to 15,000 cps at 25 OC. This anticipates the viscosity in claim 1. It is deemed that claim 5 is anticipated because it is well-known that when the temperature of a compositions is increased the viscosity is decreased, therefore the viscosity of said compositions should inherently be less than 3,000 cps in a temperature range between 40-60 C in the absence of evidence to the contrary. Said polyurethane can be the reaction product of a polyether polyol, a polyisocyanate, and a compound that possesses active hydrogen reactive with an isocyanate group and a polymerizable unsaturated group. Said polyisocyanate can be selected from the groups found on page 9 and 10, wherein hexamethylene diisocyanate and trimethylhexamethylene diisocyanate are taught. When an ordinary skilled artisan selects a polyisocyanate such as hexamethylene diisocyanate to prepare the radiation curable oligomer claim 1 is satisfied. In the alternative it would have been obvious for a skilled artisan to select an aliphatic non-aromatic diisocyanate when preparing said radiation curable oligomer. The motivation would have been to prepare a optical fiber coating composition that did not exhibit yellowing when cured as taught (evidenced) by Chawla et al in column 5, lines 28-30. Said coating upon cure will have a secant modulus of less than 0.15 kg/mm² (1.4 MPa). This anticipates claim 1 and 13. Said urethane can be a polyether polyurethane (meth) acrylate. Said monomer having one polymerizable group can be selected from pages 16-18, wherein alkoxylated reactive (meth) acrylates are anticipated. Ishikawa et al teaches that it is preferable for said monofunctional diluents be a mixture of a vinyl lactam compound and a alicyclic compound to increase water resistance, hot water resistance, acid resistance and alkali resistance in the cured product. It is deemed that Ishikawa et al does not teach using mono-functional reactive diluents comprising aromatic rings, thus claims 1, 14, and 20 are anticipated. In addition the monomer having one polymerizable group can be a mixture of

said mono- (meth) acrylate compounds and from 3 to 20-wt% of n-vinyl lactam compound. In addition to the above components in the composition an adhesion promoter, such as an organo-functional silane can added. Per synthetic example 1, Ishikawa et al teaches adding 0.33 g of said adhesion promoter. This anticipates claim 7 and 12. Because Ishikawa et al teaches that said silane coupling agents are optional components, it would have been obvious for a skilled artisan to not add such a component, especially when properties, such as strippability, are not a concern in the final products. Therefore claim 8 is read in the reference. Ishikawa et al teaches curing said composition by irradiation of 2 J/cm² or 1 J/cm² or less—see page 23. This anticipates claims 21-23. Ishikawa et al is deemed to anticipate the claimed rejection or, in the alternative, render obvious the instantly claimed invention, therefore said cured product should inherently have a glass transition temperature of less than -30 OC in the absense of evidence and/or arguments to the contrary.

Allowable Subject Matter

6. Claims 2-3, 9, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach the limitations of the above defined claims in a composition as suggested by applicants claim 1.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.